

REMARKS

The Office Action mailed March 15, 2007 has been received and reviewed. Prior to the present communication, claims 1-42 were pending in the subject application. All claims stand rejected. More specifically, claims 1-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0174434 to Walker et al. (hereinafter the “Walker reference”) in view of U.S. Patent No. 6,301,440 to Bolle et al. (hereinafter the “Bolle reference”). Claims 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Walker reference in view of the Bolle reference, further in view of U.S. Patent No. 6,636,260 to Kiyokawa (hereinafter the “Kiyokawa reference”). Reconsideration of the present application in view of the above amendments and the following remarks is respectfully requested.

Amendments to the Claims

Claim 4 has been amended herein. Care has been exercised to avoid the introduction of new matter. Support for the amendment can be found in the Specification. *See, e.g., Specification at p. 11, ¶¶ [0040]-[0041]; p. 16, ¶ [0053].*

Rejections based on 35 U.S.C. § 103(a)

The requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make

the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." *See* MPEP § 2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id.*; *see also* MPEP § 706.02(j) and § 2142.

Claims 1-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Walker reference in view of the Bolle reference. As a *prima facie* case of obviousness has not been established, Applicants respectfully traverse this rejection as hereinafter set forth.

Referring initially to claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because there is no suggestion or motivation to modify the Walker reference with the Bolle reference. Independent claim 1 is directed to a method for optimizing an image capturing device in order to improve image quality. The method includes collecting data related to a captured image from the image capturing device and storing the data externally from the image capturing device; comparing the collected data to previously stored data; and automatically determining adjustments, without prompting a user, for optimizing the image capturing device based on the comparison.

The Examiner rejected independent claim 1 by attempting to modify the Walker reference with the Bolle reference. The Walker reference is directed to methods, cameras, and devices for prompting a user of an image capturing device with questions and suggestions. *See*

Walker reference, at Abstract; p. 1, ¶ [0024]; p. 2, ¶ [0027]. The user of the image capturing device responds to the questions by providing information about a scene that the user is interested in photographing. *See id.* at p. 1, ¶ [0026] – p. 2, ¶ [0027]. After the user responds to the questions and suggestions, the method generates a number of settings adjustments based upon the user's responses. *See id* at p. 2 ¶ [0027].

The Bolle reference is directed to a system and method for computer image processing for setting the parameters for an image capturing device. *See* Bolle reference, at Abstract; col. 2, lines 35-44; col. 2, line 62 – col. 3, line 13. Using the system, image parameters are set automatically by analyzing the image to be taken and adjusting the settings according to the analyzed image. *See id.* More specifically, the system determines the type of photograph that the user of the image capturing device is trying to take based upon information from scene analysis and information from auxiliary sensors such as temperature and camera tilt angle. *See id.* at col. 2, line 62 – col. 3, line 13. Thus, fully automatically, the system may adjust the zoom or other settings. *See id.* at col. 6, lines 52-67.

Applicants respectfully submit that there is no suggestion or motivation to modify the Walker reference with the Bolle reference because modification would render the invention in the Walker reference unsatisfactory for the intended purpose. “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” MPEP § 2143.01. The intended purpose of the method in the Walker reference is to adjust settings on a image capturing device by communicating with a user of the image capturing device through user prompts, such as questions. For example, the Walker reference states that “[i]f the user responds “Yes” to [an environmental] question, then

the camera may adjust one or more of its settings (e.g. aperture, shutter speed, white balance, automatic neutral density) based on the user's response." The Office Action attempts to modify the Walker reference with the Bolle reference to provide the claim 1 feature: "automatically determining adjustments, without prompting a user, for optimizing the image capturing device based on the comparison." Such a modification would require the Walker reference to abdicate the method of prompting an image capturing device user. The method in the Walker reference, however, intentionally relies upon user prompting to adjust camera settings. Accordingly, Applicants respectfully submit that the modification would render the system in the Walker reference unsatisfactory for its intended purpose and, thus, there is no suggestion or motivation to modify the Walker reference with the Bolle reference.

Similarly, Applicants respectfully submit that there is no suggestion or motivation to modify the Walker reference with the Bolle reference because the modification would change the principle of operation of the invention in the Walker reference. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." MPEP § 2143.01. The principle of operation of the invention in the Walker reference is to generate setting adjustments by prompting the user about the environment in which the user is taking a photograph. To modify the Walker reference with the Bolle reference, eliminating the prompting feature, would destroy the principle of operation of the Walker invention because no questions could be presented to the user to determine appropriate setting adjustments. Accordingly, Applicants respectfully submit that the modification would change the principle of operation of the system in the Walker reference and, thus, there is no suggestion or motivation to modify the Walker

reference with the Bolle reference. For at least these reasons, a *prima facie* case of obviousness cannot be established for claim 1 based upon these references. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 1 is respectfully requested.

Each of independent claims 12, 20, 29, 35, and 41 has features similar to those of independent claim 1, and the Office Action rejected the claims by modifying the Walker reference with the Bolle reference similar to the rejection of claim 1. With specific reference to independent claim 41, the addition of the Kiyokawa reference fails to overcome the deficiencies in the Walker and Bolle references and, thus, *prima facie* obviousness cannot be established. Accordingly, independent claims 12, 20, 29, 35, and 41 are in condition for allowance for at least the above-cited reasons for independent claim 1. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of these claims as well.

Each of claims 2-11 depends, either directly or indirectly, from independent claim 1. Additionally, each of claims 13-19 depends, either directly or indirectly, from independent claim 12. Each of claims 21-28 depends, either directly or indirectly, from independent claim 20. Each of claims 30-34 depends, either directly or indirectly, from independent claim 29. Further, each of claims 36-40 depends, either directly or indirectly, from independent claim 35. Still further, claim 42 depends, either directly or indirectly, from independent claim 41. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness based upon the Walker and Bolle references, either alone or in combination, cannot be established for these claims for at least the same reasons as cited above. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP § 2143.03. Accordingly, withdrawal of the 35

U.S.C. § 103(a) rejection of claims 2-11, 13-19, 21-28, 30-34, 36-40, and 42 is respectfully requested as well.

Furthermore, many of the dependent claims are separately patentable because they contain additional limitations not taught or suggested by either the Walker reference or the Bolle reference. For example, dependent claim 4 recites “performing a metadata analysis with intelligent help using an accumulated usage pattern.” As indicated in the Specification, usage patterns are accumulated, allowing for intelligent help, which determines the appropriate settings based on accumulated usage data from an image capturing device. *See, e.g., Specification* at p. 11, ¶ [0040] – [0041]; p. 16, ¶ [0053]. In contrast, the Walker reference discusses an event log that keeps track of events on a camera. *See Walker reference* at p. 14, ¶ [0257]. Notably, the event log of the Walker reference does not allow for intelligent help and is not used to determine appropriate settings based on accumulated usage. *See id.* Rather, as previously stated, the Walker reference instead uses user prompting to determine appropriate settings. *See generally Walker reference.* Accordingly, Applicants respectfully submit that the Walker reference fails to teach or suggest “performing a metadata analysis with intelligent help using an accumulated usage pattern,” as recited by dependent claim 4.

Applicants respectfully submit that that Bolle reference fails to teach or suggest this limitation as well. *See generally Bolle reference.* Instead, the Bolle reference relies upon present conditions, rather than an accumulated usage pattern, to determine appropriate settings. *See Bolle reference* at Abstract; col. 2, line 62 – col. 3, line 13. Thus, the Bolle reference also fails to teach or suggest “performing a metadata analysis with intelligent help using an accumulated usage pattern,” as recited by dependent claim 4. Accordingly, Applicants respectfully submit that the Walker and Bolle references, either alone or in combination, fail to

teach or suggest all of the limitations of dependent claim 4. Accordingly, in addition to the reasons stated above, withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claim 4 is respectfully requested.

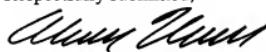
CONCLUSION

For at least the reasons stated above, claims 1-42 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-42. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

No other fee is believed due in connection with this Amendment, but the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 19-2112.

Date: April 19, 2007

Respectfully submitted,



Abran J. Kean
Reg. No. 58,540

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550